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THE BUREAU FASHION WEEK LLC

**UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA**

THE BUREAU FASHION WEEK LLC,
a South Carolina Limited Liability
Company;

Plaintiff,

vs.

THE SOCIETY MODEL
MANAGEMENT INC., a Delaware
Corporation;

Defendant.

Case No.: 2:24-cv-2784

**PLAINTIFFS' COMPLAINT FOR
DECLARATORY JUDGMENT**

JURY TRIAL DEMAND

1 Plaintiff The Bureau Fashion Week LLC, by its undersigned attorneys, files
2 this Complaint against Defendant, The Society Model Management Inc., for
3 declaratory judgment. In support thereof, Plaintiff states and alleges as follows:

4 5 **INTRODUCTION**

6
7 1. This is an action for declaratory judgment under the Anti-
8 Cybersquatting Consumer Protection Act.

9 2. Plaintiff is the owner and registrant of the domain name
10 “thesocietyfashionweek.com.”

11 3. On March 18, 2024, a WIPO panel issued a decision in favor of the
12 complainant, Defendant herein, ordering the transfer of the domain name registration
13 for “thesocietyfashionweek.com” to Defendant.

14 4. Plaintiff brings this action under 15 U.S.C. § 1114(2)(D)(v) to contest
15 the UDRP decision and prevent the improper transfer of the domain name
16 registration.

17 18 **JURISDICTION AND VENUE**

19
20 5. The Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331
21 and 1338. This Court also has subject matter jurisdiction over this action as a request
22 for federal declaratory relief pursuant to 28 U.S.C. §§ 2201 and 2202.

23 6. This Court has personal jurisdiction over Defendant because Defendant
24 initiated an administrative proceeding against Plaintiff and the domain pursuant to
25 the UDRP, in which Defendant willfully submitted itself to this Court’s jurisdiction.

26 7. Venue is proper in this district under 28 U.S.C. § 1391(b) because a
27 substantial part of the property that is the subject of this action is situated in this

1 District, specifically the Domain, and Plaintiff has a place of business within this
2 District.

3 **PARTIES**

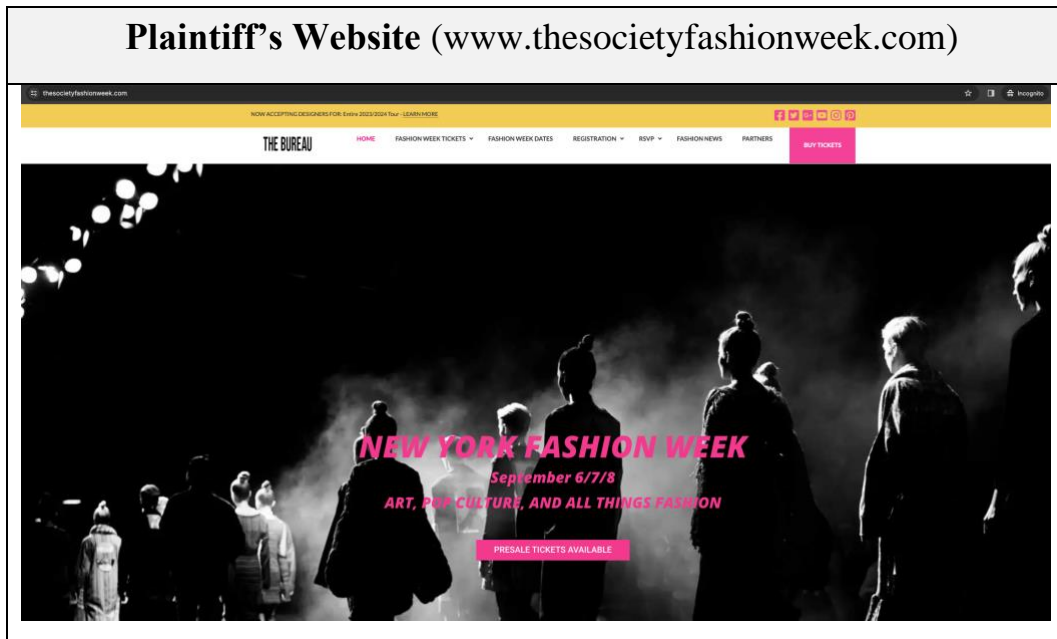
4
5 8. Plaintiff THE BUREAU FASHION WEEK LLC is a limited liability
6 company duly organized and existing under the laws of the State of South Carolina,
7 having an office and place of business at 3101 Ocean Park Blvd. Ste 100, Santa
8 Monica, CA 90405. Plaintiff is known and renowned for organizing and producing
9 major fashion week events globally.

10 9. Defendant, The Society Model Management Inc., a corporation duly
11 organized and existing under the laws of the State of Delaware, with its principal
12 place of business in 55 Hudson Yards, 3rd Floor, New York, NY 10001. Defendant
13 is a talent management and modeling agency.

14
15 **FACTUAL ALLEGATIONS**

16
17 10. Plaintiff has been operating a reputable business known as The Bureau
18 Fashion Week, which is renowned for organizing and producing major fashion week
19 events globally. These events provide a significant platform in the fashion industry,
20 primarily supporting emerging designers, independent labels, and creative fashion
21 innovators.

22 11. The Plaintiff's use of the disputed domain name
23 "thesocietyfashionweek.com" has been in connection with its bona fide offering of
24 goods and services related to fashion event production long before the initiation of
25 the dispute, underscoring the legitimacy of its operations and use of the disputed
26 domain name.



13

14 12. On January 4, 2024, Defendant initiated a Uniform Domain-Name

15 Dispute-Resolution Policy (UDRP) dispute against Plaintiff concerning the domain

16 name “thesocietyfashionweek.com.” This action was filed with the World

17 Intellectual Property Organization (WIPO), asserting claims that challenge the

18 Plaintiff’s registration and use of the disputed domain name. *See* **EXHIBIT A**.

19 13. In the UDRP dispute, Defendant claims entitlement to the domain name

20 “thesocietyfashionweek.com” based on their alleged rights in U.S. Trademark

21 Registration No. 4459660 for “THE SOCIETY,” which they assert is confusingly

22 similar to the disputed domain name. The Complainant contends that the Plaintiff’s

23 use of “thesocietyfashionweek.com” infringes upon their trademark rights and

24 constitutes bad faith registration and use under the criteria established by the UDRP.

25 14. On February 04, 2024, Plaintiff, through counsel, filed a response to the

26 UDRP dispute. *See* **EXHIBIT B**.

27 15. On March 18, 2024, a WIPO panel issued a decision in favor of the

complainant, Defendant herein, transferring the domain name registration for

1 “thesocietyfashionweek.com” to Defendant. A true and correct copy of the UDRP
2 Decision is attached hereto as **EXHIBIT C**.

3 16. The UDRP decision transferring Plaintiff's domain name registration is
4 improper because Plaintiff has legitimate interests and rights in the domain name
5 “thesocietyfashionweek.com.” The domain name has been used in good faith for
6 nearly eight years to promote fashion week events, which is entirely unrelated to the
7 Defendant's model management services. Plaintiff's registration and use of the
8 disputed domain name were not aimed at disrupting Defendant's business or
9 misleadingly diverting consumers but were genuinely intended to promote Plaintiff's
10 legitimate business activities in the fashion industry.

11 17. Moreover, Defendant filed its UDRP complaint against Plaintiff with
12 WIPO, and after limited briefing and no hearing, a panel decided the UDRP
13 complaint in Defendant's favor and ordered the domain to be transferred to
14 Defendant.

15 18. By its own terms, the UDRP contemplates judicial intervention and
16 acknowledges that the judicial outcome will override a UDRP decision. *Sallen v.*
17 *Corinthians Licenciamentos LTDA*, 273 F.3d 14, 26 (1st Cir. 2001).

18 19. Federal law and the UDRP itself provide for the Court to independently
19 resolve the dispute regarding the Domain *de novo* by determining the legality of the
20 parties' actions under the ACPA. That is, the ACPA is separate and distinct from the
21 UDRP, and the entire dispute between the parties is decided *de novo*.

22 20. The UDRP Decision provides bases for causes of action against
23 Defendant but is otherwise irrelevant when the Court decides the merits of the
24 claims. *See Storey v. Cello Holdings, L.L.C.*, 347 F.3d 370, 383 (2d Cir. 2003) (“The
25 decision issuing from the UDRP Administrative Proceeding is relevant, therefore,
26 only insofar as it triggered [the plaintiff's] right to sue under § 1114(2)(D)(v)”).

27 21. By this action, Plaintiff will establish that it has not engaged in
cyberpiracy or cybersquatting under the ACPA and that Plaintiff's use of the domain

1 in offering its services- and its registration and use of the domain to advertise its
2 services – does not infringe upon Defendant’s trademarks.

3
4 **CAUSE OF ACTION**

5 **Declaration Under Anti-Cybersquatting Consumer Protection Act**
6 **(15 U.S.C. § 1114(2)(D)(v))**

7
8 22. Plaintiff incorporates and realleges by this reference paragraphs 1
9 through 21 above as if fully set forth herein.

10 23. An actual controversy has arisen and now exists, and if unresolved, will
11 continue to exist between Plaintiff and Defendant regarding the rightful registration,
12 use, and trafficking of the domain name “thesocietyfashionweek.com.” This
13 controversy not only touches upon the application of the Anti-Cybersquatting
14 Consumer Protection Act (ACPA) and the determination of bad faith intent but also
15 directly impacts Plaintiff’s ability to maintain its online presence and associated
16 Search Engine Optimization (“SEO”) benefits, which are critical for the visibility
17 and success of its business in the digital realm.

18 24. The ACPA provides relief to domain name registrants whose domain
19 names have been wrongfully transferred in a UDRP proceeding initiated by
20 overreaching trademark owners.

21 25. 15 U.S.C. § 1114(2)(D)(v) provides that: “A domain name registrant
22 whose domain name has been suspended, disabled, or transferred under a [UDPR
23 proceeding] may, upon notice to the mark owner, file a civil action to establish that
24 the registration or use of the domain name by such registrant is not unlawful under
25 this chapter. The court may grant injunctive relief to the domain name registrant,
26 including the reactivation of the domain name or transfer of the domain name to the
27 domain name registrant.”

1 26. To prevail under 15 U.S.C. § 1114(2)(D)(v), you must demonstrate
2 several elements. First, you must be a domain name registrant. Second, your domain
3 name must have been suspended, disabled, or transferred due to a complaint. Third,
4 your registration or use of the domain name must not be unlawful. *See Black v. Irving*
5 *Materials, Inc.*, 398 F. Supp. 3d 592.

6 27. Plaintiff registered the domain name through the domain name registrar
7 GoDaddy on or around 2016.

8 28. On or around January 04, 2024, Defendant filed the UDRP Complaint
9 with WIPO, in which Defendant wrongfully accused Plaintiff of using the domain
10 in bad faith in order to have the domain transferred to Defendant. The WIPO panel
11 issued a UDRP Decision on or around March 18, 2024, in which the panel ordered
12 the domain to be transferred to Defendant. Defendant is the trademark owner who
13 initiated the UDRP proceeding,

14 29. Plaintiff's registration and use of the domain is not unlawful under the
15 ACPA. For Plaintiff to have violated the ACPA, it would require (1) that Plaintiff
16 registered, trafficked in, or used the domain; (2) that the domain name is identical or
17 confusingly similar to a protected trademark owned by Defendant; and (3) that
18 Plaintiff acted with bad faith intent to profit from that mark. *See DSPT Int'l, Inc. v.*
19 *Nahum*, 624 F.3d 1213, 1219 (9th Cir. 2010) (citing 15 U.S.C. § 1125(d)).

20 30. Firstly, it is imperative to note that Plaintiff possesses legitimate rights
21 in the domain name "thesocietyfashionweek.com," derived from its continuous and
22 bona fide use for the promotion of The Bureau Fashion Week events. This domain
23 name has been exclusively used to identify and promote Plaintiff's legitimate
24 business activities, thereby establishing a name commonly used to identify Plaintiff
25 within the fashion industry.

26 31. Second, the domain name "thesocietyfashionweek.com" is not identical
27 or confusingly similar to a trademark in which the Defendant has rights. The
Complainant's involvement in talent management and modeling does not extend to

1 organizing or producing fashion weeks, thus the term "fashion week" in the domain
2 name describes the Plaintiff's business rather than Defendant's. This significant
3 distinction underscores that the domain name accurately reflects Plaintiff's
4 specialized business activities, establishing it as a name commonly used to identify
5 Plaintiff within the fashion industry, thereby negating the claim of confusing
6 similarity.

7 32. Third, under the ACPA, the cornerstone for establishing liability is the
8 demonstration of bad faith intent to profit from a mark. As elucidated in *Aviva United*
9 *States Corp. v. Vazirani*, 902 F. Supp. 2d 1246, the ACPA outlines non-exhaustive
10 factors critical to assessing whether a defendant harbored bad faith intent to profit
11 from the use of a domain name.

12 33. Plaintiff's prior use of the domain name has been exclusively in
13 connection with the bona fide offering of goods and services, specifically, the
14 organization and promotion of fashion week events aimed at supporting emerging
15 designers and the broader fashion ecosystem. This use has been conducted in full
16 transparency and without any intent to mislead, divert consumers, or tarnish the
17 goodwill of any mark, including that of Defendant.

18 34. Plaintiff has also engaged in bona fide noncommercial or fair use of the
19 mark in a site accessible under the domain name, with no evidence of intent to divert
20 consumers from the mark owner's online location in a manner that could harm the
21 goodwill represented by the mark. There has been no offer to transfer, sell, or
22 otherwise assign the domain name to the mark owner or any third party for financial
23 gain without having used, or having an intent to use, the domain name in the bona
24 fide offering of any goods or services.

25 35. Furthermore, Plaintiff has consistently provided accurate and
26 transparent contact information in connection with the registration of the domain
27 name and maintained such information, showcasing a clear departure from the
patterns of conduct considered indicative of bad faith under the ACPA.

1 36. Critically, Plaintiff's actions and the registration of the domain name
2 "thesocietyfashionweek.com" does not align with the conduct typically associated
3 with cybersquatting, such as the registration or acquisition of multiple domain names
4 known to be identical or confusingly similar to the distinctive or famous marks of
5 others, without a legitimate purpose.

6 37. As noted in *Rigsby v. GoDaddy Inc.*, 59 F.4th 998, it is clear that the
7 ACPA's focus is on the direct actions of individuals or entities with a bad faith intent
8 to profit from a trademark. Plaintiff's registration and use of the domain name have
9 been carried out with a genuine intent to engage in lawful and constructive business
10 activities, markedly distinct from the prohibited conduct under the ACPA.

11 38. Plaintiff never considered Defendant when selecting and registering the
12 domain. Instead, Plaintiff chose the domain name "thesocietyfashionweek.com"
13 independent from the influence of any other company, product, or trademark.

14 39. It is evident that Plaintiff's actions concerning the domain name
15 "thesocietyfashionweek.com" do not meet the legal threshold for bad faith intent to
16 profit. Consequently, Plaintiff contends that its registration, use, and promotion of
17 the domain name have been conducted in good faith, meriting a declaratory
18 judgment affirming Plaintiff's rights and dispelling any notions of bad faith intent.

19 40. A judicial declaration is necessary and appropriate at this time so that
20 Plaintiff and Defendant may ascertain their rights and obligations with respect to the
21 domain name "thesocietyfashionweek.com." Absent a determination now by the
22 Court, Plaintiff faces not only ongoing uncertainty regarding its legal rights but also
23 immediate and tangible harm to its business operations. This includes a potentially
24 significant loss of SEO, which has been painstakingly built over nearly eight years.
25 SEO is crucial for drawing attendees, designers, and sponsors to Plaintiff's events,
26 and any disruption in Plaintiff's use of the domain name risks eroding its visibility
27 in search engine results, directly harming its business and the promotional efforts for
emerging designers in the fashion industry.

1 41. These events described herein warrant relief for Plaintiff under 15
2 U.S.C. § 1114(2)(D)(v), including injunctive relief to permanently return the
3 “thesocietyfashionweek.com” domain to Plaintiff.

4 **PRAYER FOR RELIEF**

5 **WHEREFORE**, Plaintiff prays for:
6

7 1. A declaration that Plaintiff’s registration, use, and trafficking in the
8 domain name “thesocietyfashionweek.com” do not constitute a violation of the
9 Anti-Cybersquatting Consumer Protection Act (ACPA)

10 2. A declaration that Defendant is not entitled to transfer of the domain
11 name registration for “thesocietyfashionweek.com.”

12 3. Such other and further relief as the Court deems just and equitable.
13

14 RESPECTFULLY SUBMITTED this 5th day of April, 2024.
15

16 **OMNI LEGAL GROUP**

17
18 /s/ Omid E. Khalifeh
19 Omid E. Khalifeh
20 Ariana Santoro
21 Louise Jillian Paris
22 Attorneys for Plaintiff
23 The Bureau Fashion Week LLC
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